

REMARKS

By this amendment, Applicants amend claims 1, 4, 10, 16, 20, and 46. Claims 1-6, 8-31, and 42-46 remain pending in this application.

As an initial matter, Applicants note that the Examiner did not initial five documents listed on a PTO Form 1449 that accompanied an Information Disclosure Statement that was filed on August 5, 2004. Applicants attach a postcard receipt acknowledging receipt of the documents by the Office and, for the Examiner's convenience, also attach additional copies of the listed documents and a clean copy of the PTO Form 1449. Accordingly, Applicants respectfully request that the Examiner consider the listed documents and return an initialed copy of the form.

In the Final Office Action¹, the Examiner rejected claims 1, 16, and 46 under 35 U.S.C. § 112, second paragraph, as being indefinite; rejected claims 1-6, 8-12, 15-22, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Byrd (U.S. Patent No. 6,081,899) in view of Rubin (U.S. Patent No. 5,638,446), and in further view of Cook (U.S. Patent No. 6,675,153); rejected claims 13, 14, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Byrd in view of Rubin and Cook, and in further view of "X.509;" and rejected claims 27-31 and 42-46 under 35 U.S.C. § 103(a) as being unpatentable over Byrd in view of Rubin and Cook, and in further view of Murray (U.S. Patent No. 6,321,333).

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

I. REJECTION UNDER § 112, ¶2

Although Applicants respectfully traverse the rejection of claims 1, 16, and 46 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants have amended claims 1, 16, and 46 for further clarity. Accordingly, Applicants request that the Examiner withdraw the rejection under 35 U.S.C. § 112, second paragraph.

II. REJECTION OF CLAIMS 1-6, 8-12, 15-22, 25, AND 26 UNDER § 103(a)

Applicants respectfully traverse the rejection of claims 1-6, 8-12, 15-22, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Byrd (U.S. Patent No. 6,081,899) in view of Rubin (U.S. Patent No. 5,638,446), and in further view of Cook (U.S. Patent No. 6,675,153) because a *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See MPEP § 2143.03. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See MPEP § 2143.01. Third, a reasonable expectation of success must exist. See MPEP § 2143.02. Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See MPEP § 2143. In this application, a *prima facie* case of obviousness has not been established

for at least the reason that the applied references fail to teach each and every element of the claims.

Claim 1 recites a method for authenticating an electronic message containing message data and an electronic address including, among other steps, “sending the digest, the temporal stamp, the unique value, and the digital signature to the electronic address as an electronic postmark” (emphasis added). The applied references, whether taken alone or in combination, do not disclose or suggest at least this element of claim 1.

In the Final Office Action, the Examiner admits that Byrd “does not teach creating a digest,” among other things. See page 3. Accordingly, since Byrd does not teach or suggest creating a “digest,” Byrd does not teach or suggest “sending the digest, the temporal stamp, the unique value, and the digital signature to the electronic address as an electronic postmark,” as recited in claim 1 (emphasis added).

Cook does not compensate for the above deficiencies of Byrd. In the Final Office Action, the Examiner contends that Cook teaches that “a unique account number is sent with a message.” See page 4. Although Applicants do not agree with the Examiner’s contention, Cook also does not teach or suggest “sending the digest, the temporal stamp, the unique value, and the digital signature to the electronic address as an electronic postmark,” as recited in claim 1 (emphasis added). Rather, according to Cook, “charge slip information and [a] time stamp certificate can in turn be digitally signed by ZAPI on behalf of the merchant, encrypted, and transmitted to member 110.” See col. 7, lines 58-61. That is, in the Cook system, the charge slip information and the time stamp certificate are sent to a member. However, there is no teaching or

suggestion of “sending the digest, the temporal stamp, the unique value, and the digital signature to the electronic address as an electronic postmark,” as recited in claim 1 (emphasis added).

Moreover, Rubin does not compensate for the above deficiencies of Byrd and Cook. The Examiner alleges that Rubin discloses “a user creating a digest (hashing) and sending an electronic file to a third party for authentication.” See Final Office Action at page 4. Although Applicants do not agree with the Examiner’s contention, Rubin also does not teach or suggest “sending the digest, the temporal stamp, the unique value, and the digital signature to the electronic address as an electronic postmark,” as recited in claim 1 (emphasis added). Rather, according to Rubin, the “secure distribution of the file is achieved when a user ... wants to access and download a file.” See col. 6, lines 5-6. To do so, the user “connects to the location of the file (i.e. A’s server) and retrieves the file and the certificate” and “then verifies that [a trusted third party’s] ... signature on the certificate is correct using ... [the trusted third party’s] public key.” See col. 6, lines 6-10. Accordingly, Rubin also does not teach or suggest “sending the digest, the temporal stamp, the unique value, and the digital signature to the electronic address as an electronic postmark,” as recited in claim 1 (emphasis added).

For at least the above reasons, Byrd, Rubin, and Cook, whether taken individually or in combination, fail to teach or suggest all of the elements of claim 1. Accordingly, a *prima facie* case of obviousness has not been established. Therefore, the Examiner should withdraw the rejection of claim 1 under 35 U.S.C. § 103(a).

Furthermore, the Examiner has not demonstrated a motivation to combine the applied references in a manner that would result in Applicants’ claimed combination.

Applicants respectfully point out to the Examiner it "is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." See In re Wesslau, 147 U.S.P.Q. 391 (C.C.P.A. 1965). See also M.P.E.P. § 2141.02, p. 2100-120. By contrast, the required motivation to combine references must "be found in the prior art, and not based on applicant's disclosure." See M.P.E.P. § 2143 (emphasis added).

In that regard, the present invention, as recited in independent claim 1, cannot be attained based merely on the combination of the applied references. One skilled in the art would only arrive at the present claimed invention by consulting Applicants' disclosure. In particular, the only way to construct the claimed invention from the cited references would be to rely on aspects found in the disclosure of the present invention. Such reliance, however, would constitute improper hindsight reasoning. Thus, Applicants submit that Byrd, Cook, and Rubin, taken alone or in combination, do not suggest the desirability of any modification to result in Applicants' claimed invention, and these references do not show that there would be any reasonable expectation of success from so doing.

Moreover, there is no suggestion or motivation to modify Byrd with Cook and Rubin to produce Applicants' claimed invention, and such combination would not be appropriate or effective. In particular, Byrd is directed to sending messages to trusted outgoing mail servers for routing to an intended recipient. See Abstract. Rubin is directed to using a trusted third party to create an electronic certificate for an electronic

file that can be used to verify the identity of the creator of the file. See Abstract.

However, Cook is directed to authorizing a transaction between a consumer and a merchant over a network where the anonymity of the consumer with respect to the merchant is maintained. See Abstract. Accordingly, Cook relates to conducting electronic transactions and preserving anonymity of the consumer. However, there is no motivation in Cook to combine the system for conducting electronic transactions such that anonymity of the consumer is preserved with the systems of Byrd and Rubin, which do not involve electronic transactions or anonymous communication. Conversely, Byrd and Rubin do not disclose a suggestion or motivation to preserve anonymity and do not even relate to electronic transactions. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01, p. 2100-124, *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Accordingly, Applicants submit that Byrd, Cook, and Rubin, taken alone or in combination, do not suggest the desirability of any modification or combination to result in Applicants’ claimed invention, and these references do not demonstrate any reasonable expectation of success from so doing. Therefore, a *prima facie* case of obviousness has not been established for at least the above additional reasons.

Independent claims 10, 16, and 20, while of a different scope from each other and claim 1, include recitations similar to those of claim 1. Accordingly, for reasons similar to those discussed above, Byrd, Rubin, and Cook, individually or in combination, fail to teach or suggest all of the elements of claims 10, 16, and 20. Accordingly, a

prima facie case of obviousness has not been established with respect to claims 10, 16, and 20, and the Examiner should withdraw the § 103(a) rejection of these claims.

Dependent claims 2-6, 8, 9, 11, 12, 15, 17-19, 21, 22, 25, and 26, depend from one of independent claims 1, 10, 16, and 20. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 2-6, 8, 9, 11, 12, 15, 17-19, 21, 22, 25, and 26 at least due to their dependencies. Therefore, the Examiner should withdraw the rejection of these claims under 35 U.S.C. § 103(a) as well.

III. REJECTION OF CLAIMS 13, 14, 23, AND 24 UNDER §103(a)

Applicants respectfully traverse the rejection of claims 13, 14, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Byrd in view of Rubin and Cook, and in further view of “X.509.” A *prima facie* case of obviousness has not been established with respect to these claims at least due to their dependency from one of independent claims 10 and 20.

For example, independent claim 10 recites among other things, “generating an electronic postmark data structure by the authentication server, the electronic postmark data structure including the hash value, item and date information, and a value that uniquely identifies the electronic postmark data structure” and “sending the electronic postmark data structure from the recipient client to a recipient at the recipient electronic address.” Independent claim 20 recites, among other things, “receiving a recipient electronic address and an electronic postmark data structure for the electronic message from an authentication server, the electronic postmark data structure including time and date information and a value that uniquely identifies the electronic postmark data structure.” As discussed above, Byrd, Rubin, and Cook, individually or in combination,

fail to teach or suggest elements similar to the above elements of independent claims 10 and 20.

The Examiner cited “X.509,” alleging the reference teaches a “certificate [containing] the subject’s public key.” See Final Office Action at page 5. Even assuming the Examiner’s characterization of “X.509” is correct, “X.509” does not compensate for the deficiencies of Byrd, Rubin, and Cook. That is, “X.509” does not teach or suggest at least the above elements of independent claims 10 and 20, from which claims 13, 14, 23, and 24 depend. Accordingly, dependent claims 13, 14, 23, and 24 are allowable at least due to their dependency from one of independent claims 10 and 20, and the Examiner should withdraw the rejection of these claims under 35 U.S.C. § 103(a).

IV. REJECTION OF CLAIMS 27-31 AND 42-46 UNDER § 103(a)

Applicants respectfully traverse the rejection of claims 27-31 and 42-46 under 35 U.S.C. § 103(a) as being unpatentable over Byrd in view of Rubin and Cook and in further view of Murray (U.S. Patent No. 6,321,333) because a *prima facie* case of obviousness has not been established.

Independent claim 27 recites a method for authenticating an electronic message including, among other steps, “creating an electronic postmark data structure for the electronic message, the electronic postmark data structure including time and date information and a value that uniquely identifies the electronic postmark data structure” and “sending the electronic postmark data structure and the recipient electronic address to a recipient client for delivery to the recipient at the recipient electronic address.” The

applied references, whether taken alone or in combination, do not disclose or suggest at least these elements of claim 27.

As discussed above, Byrd, Rubin, and Cook, individually or in combination, fail to teach or suggest “creating an electronic postmark data structure for the electronic message, the electronic postmark data structure including time and date information and a value that uniquely identifies the electronic postmark data structure,” as required by claim 27. Moreover, Murray does not teach at least this element.

The Examiner cited Murray, alleging the reference teaches “getting a digital public key authorized by a certificate authority.” See Final Office Action at page 7. Even assuming, arguendo, the Examiner’s characterization of Murray is correct, Murray does not teach or suggest “creating an electronic postmark data structure for the electronic message, the electronic postmark data structure including time and date information and a value that uniquely identifies the electronic postmark data structure” and “sending the electronic postmark data structure and the recipient electronic address to a recipient client for delivery to the recipient at the recipient electronic address,” as recited by claim 27. Accordingly, Murray does not remedy the deficiencies of Byrd, Rubin, and Cook. Since Byrd, Rubin, Cook, and Murray, whether taken individually or in combination, fail to teach or suggest all of the elements of claim 27, a *prima facie* case of obviousness has not been established. Therefore, the Examiner should withdraw the rejection of claim 27 under 35 U.S.C. § 103(a).

Independent claims 42 and 46, while of a different scope from each other and claim 27, include recitations similar to those of claim 27. Accordingly, for reasons similar to those discussed above, Byrd, Rubin, Cook, and Murray, individually or in

combination, fail to teach or suggest all of the elements of claims 42 and 46.

Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 42 and 46, and the Examiner should withdraw the § 103(a) rejection of these claims.

Dependent claims 28-31 and 43-45 depend from one of independent claims 27 and 42. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 28-31 and 43-45 at least due to their dependencies. Therefore, the Examiner should also withdraw the rejection of claims 28-31 and 43-45 under 35 U.S.C. § 103(a).

CONCLUSION

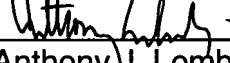
In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 19, 2007

By: 
Anthony J. Lombardi
Reg. No. 53,232

Attachments: Copy of postcard receipt from IDS of August 5, 2004;
Copy of PTO 1449 Form from IDS of August 5, 2004; and
Five listed documents submitted with IDS of August 5, 2004.



REC- VAK

PLEASE STAMP TO ACKNOWLEDGE RECEIPT OF THE FOLLOWING:

In Re Application of: Leo J. CAMPBELL, et al.

Application No.: 09/675,677

Group Art Unit: 2132

Filed: September 29, 2000

Examiner: Unknown

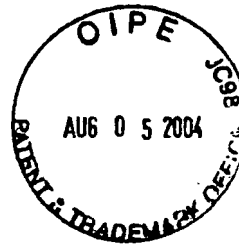
For: SYSTEM AND METHODS FOR AUTHENTICATING AN ELECTRONIC MESSAGE

1. Information Disclosure Statement Under 37 C.F.R. 1.97(b) (2 pages).
2. Form PTO 1449 (2 pages) with 31 references.

Dated August 5, 2004

Docket No.: 08049.0001

LML/WJB/B. Finley - Mail Drop 969B - Reston



(Due Date: N/A)

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